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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,517	01/28/2000	Matthew Fuchs	OIN 1012-1	2359
22470	7590	06/25/2008	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP P O BOX 366 HALF MOON BAY, CA 94019			NGUYEN, MAIKHANH	
ART UNIT	PAPER NUMBER		2176	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/493,517	FUCHS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Maikhahan Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 February 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 14, 15, 17, 18, 20-26, and 30- 37 is/are pending in the application.

4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14, 15, 17, 18, 20-26, 30, 36 and 37 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This Office Action is responsive the Election filed 02/26/2008.

Claims 14, 15, 17, 18, 20-26, and 30-37 are currently pending in this application.

Claims 31-35 have been withdrawn from the consideration. Claims 14, 25, and 36 have been amended. Claims 14, 25, and 36 are independent claims.

Applicant is required to cancel non-elected claims 31-35 in the next response to this office action.

## **Election/Restrictions**

2. Applicant's election of group I (Claims 14, 15, 17, 18, 20-26, 30, and 36-37), in the reply filed February 26, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

## Claim Objections

3. Claims 14, 18, 21, 23, and 36 are objected to because of the following informalities:

- “*the electronic document*” (Claim 14, line 2) should read “*the first electronic document*”;
- “*the document*” (Claim 14, line 3) should read “*the first electronic document*”;
- “*the first document*” (Claim 18, line 1) should read “*the first electronic document*”;
- “*the second document*” (Claim 21, line 2) should read “*the second electronic document*”;
- “*the second document*” (Claim 23, line 1) should read “*the second electronic document*”; and
- “*the electronic document*” (Claim 36, line 2) should read “*the first electronic document*.”

Appropriate correction is required.

## **Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claims 14, 15, 17, 18, 20-26, 30, and 36-37 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Regarding independent claim 14**, the method claim differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the step, nor does it require any machine or apparatus to perform the step. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing. While claim 14 performs “*defining*” and “*providing*”, it does not require any machine or apparatus to perform the step. Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claim 14 does not specify whether the entity performing the steps of “*defining*” and “*providing*” is a computer, a human,

or something else. Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept.

Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept. In addition, the claim is “so abstract and sweeping” that it would “wholly pre-empt” all applications (whether performed by a machine or a human) that are directed to a method for extending a definition of a tag in electronic document.

For the same reasons discussed *supra* with respect to independent method claim 14, the method claims 15, 17, 18, 20-24, 36 and 37 fall outside the scope of § 101.

**Regarding independent claim 25,** the claim recites a “computer network system”, the claims recites a computer network system comprising “*means for defining*,” “*means for polymorphically extending*,” and “*means for importing*.” As currently recited the “computer network system” comprises only computer software elements. Thus, the claim is a program *per se* and does not fall within any of the four enumerated categories of patentable subject matter in section 101.

For the same reasons discussed *supra* with respect to independent claim 25, the dependent claims 26 and 30 fall outside the scope of § 101

## Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Pending claims 14, 15, 17, 18, 20-26, 30, and 36-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34-38 of U.S. Patent No. 6591260. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims in the instant application and the claims in U.S. Patent No. 6591260 would have been obvious to a person of ordinary skill in the art at the time

the invention was made. The claim limitations appear to have been reworded, however, the scope of the invention appears to be generally the same.

### **Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

Claims 14, 15, 17, 18, 20-26, 30, and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by **Meltzer** (U.S. Patent No.: 6125391 A, filed 10/16/1998).

*The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.*

**As to claim 25:**

Meltzer teaches a computer network system for processing a document instant of a markup language [*See the Abstract and Fig. 1 & associated text*], the computer system comprising:

- means for defining a first tag, including a plurality of elements from a markup language, in a first schema in the computer network system [*See Col. 5, line 41 – Col. 6, line 45; Col. 9, line 56- Col. 10, line 45: a formal definition of a document structure, such as a XML document type definition DTD ... FIG. 2 is specified in an XML document type definition DTD, although other document definition architectures could be used, and includes interpretation information for the logical structures used in interpretation of instances of the documents. In addition, each of the transaction BIDs, input document BIDs and output document BIDs are specified according to an XML document type definitions. The XML type document is an example of a system based on parsed data that includes mark-up data and character data. Mark-up data identifies logical structures within the document and sets of character data identify the content of the logical structures*];
- means for polymorphically extending a definition of the first tag by use of a second schema residing on the computer network system, the second schema defining a second tag by reference to the first tag that incorporates in the second schema the plurality of elements from the markup language and by including additional elements [*Col. 19, line 13 - Col. 23, line 43 and Col. 33,*

*line 1-12: The service DTD schema may be extended with a service type element in a common business language repository ... The service description referred to by the market participant DTD defines the documents that the service accepts and generates upon competition of the service. A basic service description is specified below as a XML document transact.dtd ... such as an invoice, or a description of an exchange of value. This document type supports many uses, so the transaction description element has an attribute that allows user to distinguish among invoices, performance, offers to sell, requests for quotes and so on. The exchange may occur among more than two parties, but only two are called out, the offeror and the counter party, each of whom is represented by a pointer to a document conforming to the market participant DTD outlined above. The counter party pointer is optional, to accommodate offers to sell. The exchange description is described in the module tranprim.mod listed below, and includes pricing and subtotals];*

- means for importing the second schema into the document instance [Col. 31, line 21- Col. 32, line 67: *return a document conforming to a customized "invoice.dtd" whose definition is local. In effect, the company is promising to do business with anyone who can submit a Purchase Order that conforms to the XML specification it declares ... use these building blocks to implement the basic business forms such as those used in X12 EDI transactions as well*

*as those used in emerging Internet standards such as OTP (Open Trading Protocol) and OBI (Open Buying on the Internet)].*

**As to claim 26:**

Meltzer teaches the markup language is XML [*See the Abstract; Col. 2, line 67- Col. 3, line 45: XML*].

**As to claim 30:**

Meltzer teaches means for using an extension of the first tag (*XML is extended with a schema. The extensions add strong-typing to XML elements so that content can be readily validated*), wherein the extension of the first tag is used in a location reserved for the first tag in the document instance (*one for taking orders and the other for tracking them. Each definition expresses a contract or promise to carry out a service if a valid request is submitted to the specified Web address. The Order service here requires an input document that conforms to a standard "po.dtd" Document Type Definition located in the repository, which may be local, or stored in an industry wide registry on the network. If a node can fulfill the order, it will return a document conforming to a customized "invoice.dtd" whose definition is local. In effect, the company is promising to do business with anyone who can submit a Purchase Order that conforms to the XML specification it declares ... purchase orders typically contain the names and addresses of the buyer and seller, a set of product descriptions, and associated terms and conditions such as price*

*and delivery dates. In Electronic Data Interchange EDI for example, the X12 850 specification is a commonly used model for purchase orders)[See Col. 31, line 13 – Col. 33, line 12].*

**As to claim 14:**

The rejection of claim 25 above is incorporated herein in full. Additionally, Meltzer teaches providing references for locating the first schema and second schema in the first electronic document *[See Col. 4, lines 19-41: A definition of the interface document includes logic structures for storing an identifier of a particular transaction and at least one of definitions and references to definitions of input and output documents for the particular transaction ... it may include pointers to a location in the repository, or elsewhere in the network, of such definitions].*

**As to claim 15:**

Meltzer teaches parsing the first electronic document *[See Col. 3, line 19 – Col. 4, line 52; Col. 6, lines 29-61: The participant parses the document according to the specification stored for a transaction to identify an input document for the transaction]*, wherein the first electronic document is parsed by a parser for the markup language, the parser being stored on the server *[See Col. 23, lines 51-63; Col. 82, lines 59- 67; and Fig.11 & associated text: The server parses incoming documents and invokes the appropriate services by, for example, handing off a request for product data to a catalog server or forwarding a purchase order to an ERP system. The server also handles translation tasks, mapping the information*

*from a company's XML documents onto document formats used by trading partners and into data formats required by its legacy systems].*

**As to claim 16:**

Meltzer teaches the second tag is used in a location reserved for the first tag in the electronic document [*See Col. 9, line 56 – Col. 10, line 28: the network address or location 203 ... indicated by the tag 211 ... to an XML document type definitions*].

**As to claim 17:**

Meltzer teaches the markup language is XML [*See the Abstract and Col. 2, line 67- Col. 3, line 45: XML*].

**As to claim 18:**

Meltzer teaches the first document corresponds to, among other things, a purchase order [*See the Abstract: purchase order*].

**As to claim 20:**

Meltzer teaches accessing the second schema in a second electronic document [*See Col. 3, line 63- Col. 4, line 17; Col. 5, lines 45-56; Col. 6, lines 3-12; and Col. 30, lines 37-52: access the definition of an input document for the complementary interface ... accessing elements ... definition of documents that comprise logic structures used to build interface description*], wherein the second tag is used to encode the second electronic document [*See Col. 4, lines 43- 64 and Col. 10, line 46-*

*Col. 11, line 10: definitions of the input and output document comprise parsed data including character data encoding text characters, and mark-up data identifying sets of storage units according to the logical structures of the input and output documents].*

**As to claim 21:**

Meltzer teaches parsing the second electronic document wherein the second electronic document is parsed by a parser for the markup language, the parser being stored on the server [*See Col. 3, line 19 – Col. 4, line 52; Col. 6, lines 29-61; and Col. 8, lines 1-15: The server operates to parse the incoming documents and invoke the appropriate services*].

**As to claim 22:**

Meltzer teaches the markup language is XML [*See the Abstract; Col. 2, line 67- Col. 3, line 45: XML*].

**As to claim 23:**

Meltzer teaches the second document corresponds to a commercial transaction [*See the Abstract; Col. 1, lines 38-65: commercial transactions*].

**As to claim 24:**

Meltzer teaches the commercial transaction is selected from, among other things, an purchase order [*See the Abstract; Col. 2, lines 45-54; Col. 7, lines 38-54: a purchase order*].

**As to claim 36:**

The rejection of claim 25 above is incorporated herein in full. Additionally, Meltzer teaches wherein an application designed to work with the first tag can process the text encoded using the second tag, when the encoding is within the scope of the first tag, without modifying the application, whereby document types and applications can evolve separately [*See Col. 10, line 29 – Col. 12, line 4: an XML document type definition DTD, although other document definition architectures could be used, and includes interpretation information for the logical structures used in interpretation of instances of the documents ... participant nodes in the network establish virtual enterprises by interconnecting business systems and services with XML encoded documents that businesses accept and generate*].

**As to claim 37:**

Meltzer teaches the first (*a standard XML document type definition DTD in Fig.2*) and second schema (*<DTD NAME="markpart.dtd"> ... This element inherits the content model of the party prototype and adds a business number attribute, which serves as a key for database lookup. The business number may be used as a cross-*

*reference to/from customer id, credit limits contacts lists)reside on separate servers [See Col. 7, line 55 - Col. 8, line 15].*

## **Response to Arguments**

7. Applicants' arguments filed 11/30/2007 have been fully considered but are moot in view of the new ground(s) rejection.

## **Conclusion**

8. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

## **Contact information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. N./

Examiner, Art Unit 2176

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178